

**REMARKS**

This Response is being submitted in response to the Office Action mailed May 21, 2003, relating to the above-identified applications. Applicants respectfully traverse and request reexamination and reconsideration. Claims 1-34 remain pending.

**I. Summary of the Examiner's Rejections and Objections**

Claims 1-5, 7-14, 16-25, and 29-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Greenberg, et al.* (U.S. Patent No. 5,793,352) in view of *Perlman* (U.S. Patent No. 6,169,879).

Claims 6, 15, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**II. Applicants' Response to the Examiner's Rejections**

The Applicants traverse the rejection of the aforementioned claims for the reasons set forth in greater detail below.

Applicants submit that *Greenberg, et al.*, *Perlman*, or any combination thereof fails to disclose each and every element of Applicants' claimed subject matter, and respectfully request the Examiner to withdraw the rejections. In addition, Applicants submit that *Greenberg, et al.*, *Perlman*, or any combination thereof does not disclose, teach or suggest, either implicitly or explicitly, Applicants' claimed subject matter.

It is well-established that to establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. In addition, there must be some teaching, motivation or suggestion in either the prior art, or the references themselves to make the combination asserted by the Examiner.

The Examiner states that:

[T]he Examiner [has] recognized that references cannot arbitrarily combined and that there must be some reason why one skill in the art would be motivated to make the proposed combination of the primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1985). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining reference is what the combination of disclosures taken as a whole would suggest to one skill in the art. *In re McLaughlin*,

170 USPQ 209 (CCPA 1971). References are evaluated by what suggest to one versed in the art, rather by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

Applicants respectfully submit that the Examiner's statements are a misrepresentation of current Federal Circuit case law. In *In re Lee*, the Federal Circuit held that the Patent & Trademark Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies. 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

"When patentability turns on the questions of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 20010 ('the central questions is whether thee is a reason to combine [the] references,' a question of fact drawing on the *Graham* factors)."

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 299 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ('a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential component of an obviousness holding"' (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembicza*k, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ('Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the application); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984))."

"The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the

reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Roufeet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ('even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.'); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references')."

Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

One case on which the Examiner relies, *In re Bozek*, 57 C.C.P.A. 713, 416, F.2d 1385, 163 USPQ 545 (1969), mentions "common knowledge and common sense." However, *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Further, *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Moreover, *Bozek* does not after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that *Bozek's* reference to common knowledge 'does not in and of itself make it so' absent evidence of such knowledge.

Measuring a claimed invention against the standard established in 35 U.S.C. §103 requires the oft-difficult, but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references in the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious

effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.*

Case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ 2d 164, 1617 (Fed. Cir. 1999). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *Id.*; See, e.g., *Interconnect Planning Corp. v. File*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although "the suggestion more often comes from the teachings of the pertinent references." *Dembiczak* at 1617; *In re Roffet*, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) ("The board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them").

The showing of such suggestion, teaching or motivation must be clear and particular. *Dembiczak* at 1617 (emphasis added); See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *Dembiczak* at 1617; See, e.g. *Elmurry v. Arkansas, Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 207, 217 (CCPA 1977).

Therefore, the Examiner must make particular findings regarding the locus of the suggestion, teaching or motivation to confine the prior art references. *Dembiczak* at 1617 (emphasis added).

#### A. Rejection of claims 1-5

The high density audio/video input/output interconnection device as defined in claim 1, calls for, among other things:

"... a plug for stereo audio output interconnected to the high density connector for interface with a computer."

The structure and associated functionality of the aforementioned limitation is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof. Therefore, claim 1 cannot be obvious under *Greenberg, et al., Perlman*, or any combination thereof. Nor has the Examiner provided recitation where the entirety of the aforementioned limitation is disclosed in *Greenberg, et al.* or *Perlman*. Applicants request a specific showing by the Examiner of the particular locus of the disclosure or teaching of the aforementioned limitation. In each of the three prior Office Actions, the Examiner has been unable to comply with Applicants' request for showing. Consequently, the obviousness rejection of claim 1 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

In rejecting claim 1, the Examiner has seemingly ignored the aforementioned limitation and broadly asserted that such ignored limitation is disclosed in *Greenberg, et al.* More specifically, on page 2, paragraph 2 of the Office Action, the Examiner states that

“... Greenberg's device discloses a block or housing having a longitudinal axis including a top surface, bottom surface, front surface, back surface and side surfaces such that the first and second side surfaces are oppositely disposed (see figs. 1-4); a plurality of jacks (40, 40', 42, 44, 53, 53' 42) for connection with peripheral devices disposed on the first and second sides surfaces; a recessed portion formed on the first side surface having at least one of the plurality jacks (53) disposed therein; a projection portion formed on the second side surface having at least one of the plurality of jacks (44') disposed therein; a cable (54) associate with the back surface and high density conductor connection at 56, 58 (see fig. 1 col. 3, lines 54-59) with the jacks, the jacks with audio, video, stereo-audio inputs and outputs (see figs. 1-2, 4) with the diagram showing the stereo audio input and output (42, 84, 84'), the video input by using the mouse at 44, 44' to select the input and output at 45, 40, 53, 55) or see col. 1, line 36-56, cols 3-4, lines 21-60.”

The Examiner submits that such rejection fails to disclose the aforementioned limitation or provide an indication of where on the *Greenberg, et al.* device the “plug for stereo audio output interconnected to the high density connector for interface with a computer” is disclosed. The Examiner has not discussed the disclosure, teachings or suggestions of *Perlman* in view of the aforementioned limitation nor how *Greenberg, et al.* might be modified by or combined with the disclosure, teachings or suggestions of *Perlman*. Accordingly, the aforementioned limitation of claim 1 is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof.

Applicants submit that the obviousness rejection is improper 35 U.S.C. § 103(a) or MPEP § 706.02 because each and every limitation of claim 1 is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof, nor has the Examiner pointed to any portion of *Greenberg, et al., Perlman*, or any combination thereof which discloses the entirety of the aforementioned limitation.

Consequently, Applicants submit that *Greenberg, et al., Perlman*, or any combination thereof does not render the invention as defined in claim 1 obvious because the Examiner has seemingly ignored a principal limitation of claim 1, and *Greenberg, et al., Perlman*, or any combination thereof does not disclose a high density audio/video input/output interconnection device having the structure and functionality as defined in claim 1. Accordingly, reconsideration and withdrawal of rejection of claim 1 is respectfully requested.

Claims 2-5 directly or indirectly depend upon include all limitations of claim 1 and are allowable at least for the reasons associated with claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 1-5 is respectfully requested.

B. Rejection of claims 7-14 and 16-18

Claim 7 is directed to a novel high density audio/video input/output connector block. Claim 7 includes the following limitations, *inter alia*:

“... a projecting portion formed on the second side surface having at least one of the pluralities of jack disposed therein; and ...”

The structure and functionality of the aforementioned limitation is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof. Therefore, claim 7 cannot be obvious under *Greenberg, et al., Perlman*, or any combination thereof. Nor has the Examiner provided recitation where the entirety of the aforementioned limitation is disclosed in *Greenberg, et al.* or *Perlman*. Consequently, the obviousness rejection of claim 7 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

In rejecting claim 7, the Examiner asserts that *Greenberg, et al.* discloses a projecting portion formed on the second side surface. More specifically on page 2, paragraph 3 of the Office Action, the Examiner states that the following structure discloses the aforementioned limitation:

“... a projecting portion formed on the second side surface having at least one of the plurality of jacks (44') disposed therein; ...”

However, Applicants respectfully submit that the Examiner has not specifically identified the structure associated with the projecting portion. Rather, jack (44'), as shown in FIGS. 3, 5 and 6, is clearly disposed recessed from the side wall 132(a) and the ports 146. The structure identified by reference no. 44' is a pointer control terminal mounted with an exterior surface flush or coplanar with sidewall 132(a) as clearly shown in FIG. 3. The structure identified by reference no. 132(b) is a side wall of the cap 134 as shown in FIG. 5. Cap 134 fits over base 120 so that sidewalls 132(a) and 132(b) meet in vertically aligned engagement. See *Greenberg, et al.* column 8, lines 14-15. Accordingly, the sidewalls 132(a) and 132(b) are parallel with respect to one another and in fact define the second surface as claimed, from which the recessed portion is defined. Pointer control terminal 44' clearly is not disposed recessed from or on a projection from the second side surface. Rather, pointer control terminal 44' is disposed on the second side surface. Consequently, as correctly interpreted, *Greenberg, et al.* does not disclose, teach or suggest the aforementioned limitation. Moreover, *Greenberg, et al.* states that cover 142 is rotatable and includes semicircular flange portion 152 which extends radially from the center cap portion 150 and is complimentary with approximately one-half of circular flange 138. A semi-cylindrical sidewall cover 156 depends downwardly from flange portion 152 to cover about one-half of the cylindrical sidewall 132 of base 130, as desired. See *Greenberg, et al.* column 8, lines 32-40. The sidewall cover 156 may be disposed immediately adjacent the second side surface and covers each of the selected jacks disclosed in *Greenberg, et al.* Accordingly, the jacks, in particular 44' as cited by the Examiner, must be disposed flush or recessed with respect to the first or second surfaces in order for *Greenberg, et al.* to function as described and constructed. Consequently, *Greenberg, et al.* fails to disclose or suggest the aforementioned limitation and, in fact, teaches away from the aforementioned limitation.

Further, the Examiner has not discussed the disclosure, teachings or suggestions of *Perlman* in view of the aforementioned limitation nor how *Greenberg, et al.* might be modified by or combined with the disclosure, teachings or suggestions of *Perlman*. Applicants request a specific showing of the aforementioned limitation.

Applicants submit that the obviousness rejection is improper 35 U.S.C. § 103(a) or MPEP 706.02 because each and every limitation of claim 7 is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof, nor has the Examiner pointed to any portion of

*Greenberg, et al., Perlman*, or any combination thereof which discloses the entirety of the aforementioned limitation.

Consequently, Applicants submit that *Greenberg, et al., Perlman*, or any combination thereof does not render the invention as defined in claim 7 obvious because the Examiner has seemingly ignored a principal limitation of claim 7, and *Greenberg, et al., Perlman*, or any combination thereof does not disclose a high density audio/video input/output interconnection device having the structure and functionality as defined in claim 7. Accordingly, reconsideration and withdrawal of rejection of claim 7 is respectfully requested.

Claims 8-14 and 16-18 directly or indirectly depend upon and include all of the limitations of claim 7 and are allowable at least for the reasons associated with claim 7. Accordingly, reconsideration and withdrawal of the rejection of claims 7-14 and 16-18 is respectfully requested.

C. Rejection of Claims 19-25

Claim 19 is directed to a novel high density audio/video input/output connector block. Claim 19 includes the following limitations, *inter alia*:

“... at least one audio jack disposed on the first and second sides defined in a first planes; and,

at least one video jack disposed on the first and second sides defined in a second plane, where that the first and second planes are substantially parallel such that audio and video jacks are offset.”

The structure and functionality of the aforementioned limitation is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof. Therefore, claim 19 cannot be obvious under *Greenberg, et al., Perlman*, or any combination thereof. Nor has the Examiner provided recitation where the entirety of the aforementioned limitation is disclosed in *Greenberg, et al. or Perlman*. Consequently, the obviousness rejection of claim 19 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

In rejecting claim 19, the Examiner has seemingly ignored the aforementioned limitations and broadly asserted that such ignored aforementioned limitations are disclosed in *Greenberg, et al. or Perlman*. More particularly, the Examiner asserts that:

“... Greenberg’s and Perlman devices disclose the aforementioned limitations, but fail to explicitly disclose different arrangement features for the jacks connectors. It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to place a rib on the top surface and the cable disposed at an offset from the longitudinal axis, first side surface being parallel to the second side surface or angular arrangement of elements, since it has been held that rearranging parts of an invention involves only routine skill in the art . . . ”

However, Applicants respectfully submit that the structure of the aforementioned limitations are clearly not disclosed in *Greenberg, et al., Perlman*, or any combination thereof. It is improper for the Examiner to assert that the aforementioned limitations amount to nothing more than the rearrangement of parts when the Examiner has failed to specifically cite to Applicants where such structure and functionality are disclosed in *Greenberg, et al., Perlman*, or any combination thereof.

Applicants respectfully submit that the Examiner’s obviousness analysis is limited to an over-generalized discussion of the cited prior art references and an inapplicable case citation directed to rearrangement of parts which are combined to read on the claimed invention. However, this reference-by-reference limitation analysis and non-specific catch-all case citation fails to demonstrate how the *Greenberg, et al., Perlman*, or any combination thereof teach or suggest the combination to yield the aforementioned limitations. Further, Applicants respectfully submit that there is no motivation or teaching found in any of the references to suggest that modification or combination as suggested by the Examiner would be obvious.

Simply because the teachings of *Greenberg, et al.* or *Perlman* were known does not provide the required motivation to combine necessary to establish *prima facie* obviousness. Further, parts or structural elements which have not been disclosed in any cited reference cannot be used to support an obviousness rejection without adequate support or motivation. Applicants respectfully submit that the Examiner has failed to show any teaching related to such motivation as required. Thus, the asserted level of skill in the art cannot serve as a crutch for the Examiner to reach a conclusion of obviousness.

In accordance with MPEP §2144, Applicants believe that they have specifically pointed out the errors in the Examiner’ rejection and request that the Examiner provide specific citation of each and every element of the aforementioned limitations and the parts alleged to be rearranged by documentary proof from the record. The Examiner has again failed to cite the specific limitations claimed by Applicants.

Applicants submit that the obviousness rejection is improper 35 U.S.C. § 103(a) or MPEP 706.02 because each and every limitation of claim 19 is not disclosed in *Greenberg, et al.*

*et al.*, *Perlman*, or any combination thereof, nor has the Examiner made a showing or pointed to any portion of *Greenberg, et al.*, *Perlman*, or any combination thereof which discloses the entirety of the aforementioned limitation.

Consequently, Applicants submit *Greenberg, et al.*, *Perlman*, or any combination thereof does not render the invention as defined in claim 19 obvious because the Examiner has seemingly ignored these principal limitations of claim 19, and *Greenberg, et al.*, *Perlman*, or any combination thereof does not disclose a high density audio/video input/output interconnection device having the structure and functionality as defined in claim 19. Accordingly, reconsideration and withdrawal of rejection of claim 19 is respectfully requested.

Claims 20-25 directly or indirectly depend upon include all the limitations of claim 19 and are allowable for the reasons associated with claim 19. Accordingly, reconsideration and withdrawal of the rejection of claims 19-25 is respectfully requested.

D. Rejection of Claims 29-33

Claim 29 is directed to a novel high density audio/video input/output connector block. Claim 29 includes the following limitations, *inter alia*:

“... a plug for stereo audio output interconnected to the high density connector for interface with a computer.”

The structure and associated functionality of the aforementioned limitation is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof. Therefore, claim 29 cannot be obvious under *Greenberg, et al.*, *Perlman*, or any combination thereof. Nor has the Examiner provided recitation where the entirety of the aforementioned limitation is disclosed in *Greenberg, et al.* or *Perlman*. Applicants again request a specific showing by the Examiner of the particular locus of the disclosure or teaching of the aforementioned limitation. Consequently, the obviousness rejection of claim 29 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

The Examiner's rejection of claim 29 is set forth in detail above in Section II(A). The Examiner submits that such showing discloses the aforementioned limitation without providing an indication of where on the *Greenberg, et al.* device the “plug for stereo audio output interconnected to the high density connector for interface with a computer” is disclosed. The Examiner has not discussed the disclosure, teachings or suggestions of *Perlman* in view of the aforementioned limitation nor how *Greenberg, et al.* might be modified by or combined with

the disclosure, teachings or suggestions of *Perlman*. Accordingly, the aforementioned limitation of claim 29 is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof.

Applicants submit that the obviousness rejection is improper 35 U.S.C. § 103(a) or MPEP § 706.02 because each and every limitation of claim 29 is not disclosed in *Greenberg, et al., Perlman*, or any combination thereof, nor has the Examiner pointed to any portion of *Greenberg, et al., Perlman*, or any combination thereof which discloses the entirety of the aforementioned limitation.

Consequently, Applicants submit *Greenberg, et al., Perlman*, or any combination thereof does not render the invention as defined in claim 29 obvious because the Examiner has seemingly ignored a principal limitation of claim 29, and *Greenberg, et al., Perlman*, or any combination thereof does not disclose a high density audio/video input/output interconnection device having the structure and functionality as defined in claim 29. Accordingly, reconsideration and withdrawal of rejection of claim 29 is respectfully requested.

Claims 30-33 directly or indirectly depend upon include all limitations of claim 29 and are allowable at least for the reasons associated with claim 29. Accordingly, reconsideration and withdrawal of the rejection of claims 29-33 is respectfully requested.

### III. Allowable Subject Matter and New Claims

The Applicants wish to thank the Examiner for indicating that the invention as defined in claims 26-28 are allowable over the art of record, and that the invention as defined in claims 6, 15 and 34 would be allowable if re-written in independent form.

CONCLUSION

Based on the above amendments and remarks, the Applicants submit that claims 1-34 are now in proper condition for allowance and such action is earnestly solicited.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0441 or any payment in connection with this communication, including any fees for extension of time, which may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

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